

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 19

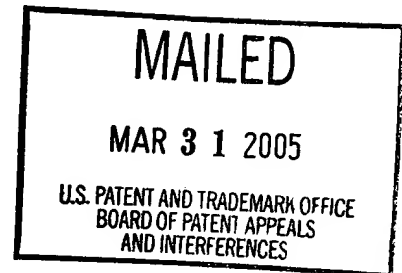
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MASAHITO NIIKAWA
and
HIROAKI KUBO

Appeal No. 2004-1567
Application No. 09/528,356

ON BRIEF



Before OWENS, LEVY, and DELMENDO, Administrative Patent Judges.
DELMENDO, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal under 35 U.S.C. § 134 (2004) from the examiner's final rejection of claims 1 through 10, 12 through 24, 26, and 27 (final Office action mailed on Jan. 14, 2003), which are all of the claims pending in the above-identified application.

The subject matter on appeal relates to: (i) a driving device (claims 1-5); (ii) to an information processing device (claims 6-10 and 12-19); and (iii) to an information processing

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system (claims 20-24, 26, and 27). According to the appellants, "[t]he present invention relates to an information processing device, system and driver including a capability for display of image information on a display of a storage medium, such as memory cards 40 (Figure 5), 56 (Figure 9) or 60 (Figure 10) for a digital camera 100 (Figures 16 and 17)." (Appeal brief filed on Jul. 25, 2003 at 3.) Further details of this appealed subject matter are recited in representative claims 1, 6, and 20, the only independent claims on appeal, reproduced below:

1. A driving device which accepts a storage medium comprising a memory section to be stored with image data and a display section to display information and the image data to the memory section, said driving device comprising:

a receiving section where the storage medium can be set and ejected, the display section of the storage medium being hidden and not being viewable when the storage medium is set in the receiving section; and

a driver which records the image data to the memory section of the storage medium and renews information and a display image displayed on the display section of the storage medium in accordance with the recorded image data while the storage medium is set in the receiving section.

6. An information processing device which accepts a storage medium comprising a memory section to be stored with image data and a display section to display information and the image data, said information processing device comprising:

a receiving section where the storage medium can be set and ejected, the display section of the storage medium being hidden and not being viewable when the storage medium is set in the receiving section;

a data processing section which processes the image data; and

a driver which records the image data processed by the data processing section to the memory section of the storage medium and renews information and a display image displayed on the display section of the storage medium in accordance with the recorded image data while the storage medium is set in the receiving section.

20. An information processing system comprising:

a storage medium which has a memory section to be stored with image data and a display section to display information and the image data; and

an information processing device where the storage medium is set to be accessed by the information processing device and can be ejected, the display section of the storage medium being hidden and not being viewable while the storage medium is set in the information processing device;

wherein the information processing device comprises:

a data processing unit which processes the image data; and

a driver which records the image data processed by the data processing unit to the memory section of the storage medium and renews information and a display image on the display section of the storage medium in accordance with the image data.

The examiner relies on the following prior art references as evidence of unpatentability:

Tagashira et al. (Tagashira)	4,200,390	Apr. 29, 1980
Cannon et al. (Cannon)	5,600,563	Feb. 04, 1997
Hatano et al. (Hatano)	5,731,861	Mar. 24, 1998

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Bloch et al. (Bloch)	5,745,102	Apr. 28, 1998
Houlberg et al. (Houlberg)	5,887,198	Mar. 23, 1999 (filed Apr. 07, 1997)
Kazami et al. (Kazami)	5,937,107	Aug. 10, 1999 (filed Aug. 15, 1997)

The appealed claims stand rejected under 35 U.S.C. § 103(a)
as follows:

- I. claims 1, 2, 6, 7, 12 through 14, 20, 21, 26, and 27
as unpatentable over Bloch in view Kazami (answer at
4-6);
- II. claims 3 through 5, 8 through 10, and 22 through 24 as
unpatentable over Bloch and Kazami, as applied to
claims 1, 2, 6, 12 through 14, 20, and 21, and further
in view of Hatano (id. at 6-7);
- III. claims 15 and 16 as unpatentable over Bloch and
Kazami, as applied to claims 1, 2, 6, 7, 12 through
14, 20, and 21 above, and further in view of Houlberg
(id. at 7-8);
- IV. claim 17 as unpatentable over Bloch and Kazami, as
applied to claim 6, and further in view of Cannon (id.
at 8); and

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V. claims 18 and 19 as unpatentable over Bloch, Kazami, and Cannon, as applied to claim 17, and further in view of Tagashira (id. at 8-9).

We reverse all five rejections for essentially the reasons sets forth in the appeal brief filed on Jul. 25, 2003 and the reply brief filed on Aug. 27, 2004.

It is by now axiomatic that, under 35 U.S.C. § 103(a), the initial burden of establishing a prima facie case of obviousness rests on the examiner. In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); In re Piasecki, 745 F.2d 1468, 1471-72, 223 USPQ 785, 787-88 (Fed. Cir. 1984).

Where prior art references are combined to arrive at the claimed subject matter, the examiner must point to some motivation, teaching, or suggestion in the prior art themselves that would have led one of ordinary skill in the art to make the proposed combination. In re Dembiczak, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999) ("The best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references."); In re Warner, 397 F.2d 1011, 1016, 154 USPQ 173, 177 (CCPA 1967) ("Where the invention sought to be patented

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resides in a combination of old elements, the proper inquiry is whether bringing them together was obvious and not, whether one of ordinary skill, having the invention before him, would find it obvious through hindsight to construct the invention from elements of the prior art.").

Here, the examiner has not adequately established a prima facie case of obviousness, because the record is devoid of any showing of the requisite motivation, suggestion, or teaching in the prior art as required under 35 U.S.C. § 103(a). The independent claims on appeal recite "a driver which records the image data to the memory section of the storage medium and renews information and a display image displayed on the display section of the storage medium..." (emphasis added; claim 1), "a driver which records the image data processed by the data processing section to the memory section of the storage medium and renews information and a display image displayed on the display section of the storage medium..." (emphasis added; claim 6), and "a data processing unit which processes the image data...a driver which records the image data processed by the data processing unit...and renews information and a display image on the display section of the storage medium..." (emphasis added; claim 20).

Bloch, the principal prior art reference common to all five rejections, teaches an apparatus for visually displaying information indicative of the data stored on a data storage device when the data storage device is not inserted in a data reader device. (Column 1, lines 64-67.) Specifically, Bloch teaches that the apparatus includes: a receiving device, adapted to reside on the data storage device, for receiving data representing information indicative of the data stored on the data storage device; a memory device, adapted to reside on the data storage means and coupled to the receiving means, for storing and decoding the received digital data and for providing a digital signal representing the decoded digital data; and a display device, adapted to reside on the data storage device and coupled to the memory device, for receiving and displaying the digital signal representing the decoded digital data such that information indicative of the data stored on the storage device can be viewed when the storage device is not inserted in the data reader device. (Column 1, line 67 to column 2, line 13.)

In Figure 1A, Bloch describes a floppy disk 120 including memory 114 and a liquid crystal display (LCD) 110. (Column 3, line 24 to column 4, line 48.) Bloch further illustrates how the floppy disk 120 can be fully inserted into a floppy disk

drive 210, which would necessarily result in the LCD 110 being hidden from view. (Figure 2A.) Bloch describes the operation of the apparatus as follows:

More particularly, an exemplary embodiment of the present invention utilizes a specially-designed floppy disk housing along with additional circuitry added to the personal computer which accesses the floppy disk (e.g., a modified floppy disk drive) to automatically update a programmable, dynamic display means operatively and conveniently located on the floppy disk housing such that it stores and can display a current list of selected filenames stored on the storage device. This automatic labelling aspect of the present invention essentially involves storing the names of predetermined files (e.g., possibly only *.doc or *.exe files) or other labelling information (e.g., disk volume labels) in a memory which then drives, for example, a liquid crystal device (LCD) display secured to the floppy disk housing. [Underscoring added.]

Unlike the invention recited in the appealed claims, Bloch's disk drive system/processing unit does not record image data on the memory section of the floppy disk (i.e., the storage medium). Instead, Bloch discloses the recording of filenames (i.e., text data) on the floppy disk, as noted above. (Column 3, lines 24-38.) In an attempt to account for this difference, the examiner relies on Bloch's disclosure at column 3, lines 32-38, column 5, lines 45-52, and column 10, lines 15-21. (Answer at 4.) The relied upon disclosures of Bloch, however, are concerned with the recording and displaying of alphanumeric text

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for identifying the files in or labeling the volume of the storage medium. (Column 3, lines 32-37; column 5, lines 48-52; column 10, lines 15-21.) On this point, nothing in Bloch substantiates the examiner's apparent belief that the phrase "any other relevant associated information" (column 10, lines 20-21) relates to or is even suggestive of image data. Also, while the examiner notes Bloch's teaching that the system can be used in Apple Macintosh systems (answer at 5), nothing in the record substantiates the allegation that such a system is necessarily concerned with the recording and displaying of image data.

The teachings of Kazami, the other reference applied in each of the examiner's rejections, are of no help to the examiner's position. Kazami teaches "a thumbnail image signal output apparatus which can accurately represent, even in thumbnail image display, the details of processing which has been performed upon the images in full screen display." (Column 1, lines 40-44.) Kazami, however, teaches the use of, for example, CPU 26 to display thumbnail images on a display device 28. (Column 2, line 49 to column 3, line 8.) Thus, Kazami's disclosure has nothing to do with recording and displaying

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alphanumeric text on an LCD display disposed on a floppy disk for purposes of identifying the contents therein.

Because the examiner's analysis does not identify any specific motivation, teaching, or suggestion in the prior art to combine the references to arrive at the subject matter of the appealed claims, we cannot affirm. The requisite motivation, teaching, or suggestion cannot be based on mere unsupported allegations or speculation; rather, it must be based on objective evidence of record. In re Lee, 277 F.3d 1338, 1343, 61 USPQ2d 1430, 1433 (Fed. Cir. 2002) ("The factual inquiry whether to combine references must be thorough and searching....It must be based on objective evidence of record. This precedent has been reinforced in myriad decisions, and cannot be dispensed with.").

Hatano was applied against appealed claims 3 through 5, 8 through 10, and 22 through 24 for the proposition that a display may include a material with memory effect, i.e. a liquid crystal that exhibits a cholesteric phase at room temperature. (Answer at 6-7.) The relied upon teachings of Hatano, however, do not remedy the deficiencies in the examiner's basic combination of Bloch and Kazami.

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Houlberg was applied against appealed claims 15 and 16 for the proposition that a driver can format a memory section. (Answer at 7.) Again, however, the relied upon teachings of Houlberg do not remedy the deficiencies in the examiner's basic combination of Bloch and Kazami.

Cannon was applied against appealed claims 17 through 19 in two separate rejections for the proposition that the image processing device may be a printer. (Answer at 8.) We note, however, that Bloch's disclosure does not relate to the processing of images. Rather, Bloch's disclosure is concerned with alphanumeric text data, as we discussed above. Regardless, the relied upon teachings of Cannon, like those of Hatano and Houlberg, do not cure the deficiencies in the examiner's basic combination of Bloch and Kazami.

Tagashira was applied against appealed claims 18 and 19 for the proposition that a "driver renews information displayed on the display section about a number of prints on completion of printing." (Answer at 8.) Again, we note that the relied upon teachings of Tagashira do not cure the deficiencies in the examiner's basic combination of Bloch and Kazami.

For these reasons, we reverse the examiner's rejections under 35 U.S.C. § 103(a) of: (i) claims 1, 2, 6, 7, 12 through

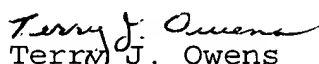
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14, 20, 21, 26, and 27 as unpatentable over Bloch in view
Kazami; (ii) claims 3 through 5, 8 through 10, and 22 through 24
as unpatentable over Bloch and Kazami, as applied to claims 1,
2, 6, 12 through 14, 20, and 21, and further in view of Hatano;
(iii) claims 15 and 16 as unpatentable over Bloch and Kazami, as
applied to claims 1, 2, 6, 7, 12 through 14, 20, and 21 above,
and further in view of Houlberg; (iv) claim 17 as unpatentable
over Bloch and Kazami, as applied to claim 6, and further in
view of Cannon; and (v) claims 18 and 19 as unpatentable over
Bloch, Kazami, and Cannon, as applied to claim 17, and further
in view of Tagashira.

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The decision of the examiner is therefore reversed.

REVERSED


Terry J. Owens)
Administrative Patent Judge)


Stuart S. Levy)
Administrative Patent Judge)


Romulo H. Delmendo)
Administrative Patent Judge)

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